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09/964,475	09/28/2001	Takuya Okamoto	ASA-724-02	3236
24956 7590 11/10/2008 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314				
EXAMINER				
COLBERT, ELLA				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/964,475

Applicant(s)

OKAMOTO ET AL.

Examiner

Ella Colbert

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-41 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-41 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 34-41 and 46-48 are pending and no claims have been amended in this communication filed 07/01/08 entered as Response After Non-Final Rejection.

Claim Objections

Claims 34 -41 and claims 46-48 are objected to because of the following informalities: Claim 34 recites "generating an original analyzed structured document of a structured document to be searched". This claim limitation reciting "structured document" twice is redundant. A better recitation would be "generating an original analyzed structured document to be searched". Also, claim 34 recites "removing predefined elements from the original analyzed structured document, ... strings of higher-rank elements and of the removed predefined elements to thereby generate a structured document for full-text search ...". This claim limitation appears to have a word omitted. For example, it is believed that this claim limitation should recite "removing predefined elements from the original analyzed structured document, ... strings of higher-rank elements and the removed predefined elements to thereby generate a structured document for a full-text search ...". Claims 46-48 have similar problems as those in claim 34. Claim 35 recites in the preamble "A structured document searching and displaying method according to claim". The preamble of this claim should recite "The computer-implemented method for searching and displaying the structured document according to claim". Claims 36-41 have a similar problem. Appropriate correction is required.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-41 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,778,400) Tateno in view of (US 5,956,726) Aoyama et al, hereafter Aoyama.

Claim 34. Tateno discloses, A computer-implemented method for searching and displaying a structured document including performing an element designated full- text search o the structured document and highlighted displaying of information on a position of characters meeting a search result query in the structured document, the method comprising the steps of: generating an original analyzed structured document of a structured document to be searched (col. 4, lines 4-11).

Tateno failed to disclose, removing predefined elements from the original analyzed structured document, and concatenating content character of higher-rank elements and of the removed predefined elements to thereby generate a structured document for full-text search including the concatenated content character strings, generating information

for restoring the removed predefined elements. Aoyama disclosed, removing predefined elements from the original analyzed structured document, and concatenating content character of higher-rank elements and of the removed predefined elements to thereby generate a structured document for full-text search including the concatenated content character strings, generating information for restoring the removed predefined elements (col. 3, lines 17-47).

Tateno discloses, acquiring information on a position of a character string meeting the search query in the structured document for full-text search (col. 9, line 54-col. 10, line 4); converting the information on the position of the character string meeting the search query on the structured document for the full-text search into information on a the position of the character string meeting the search query in the original analyzed structured document (col. 10, lines 5-25).

Tateno failed to disclose, adding element information for the highlighted displaying of the information on the position of the characters meeting the search .query, to the original analyzed structured document. Aoyama disclosed, adding element information for the highlighted displaying of the information on the position of the characters meeting the search .query, to the original analyzed structured document (col. 13, line 25-col. 14, line 9).

Tateno discloses, generating a text string of the structured document, from the analyzed structured document with the element information added thereto (col. 4, lines 20-33). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Aoyama in Tateno because such an

incorporation would allow Tateno to have a structured document with embedded therein containing information on the logical structure of a document.

Claim 48, is rejected for the similar rationale as given above for claim 34. Aoyama discloses a computer readable medium and program in col. 6, lines 31-48. Claims 35. Tateno and Aoyama failed to disclose, A structured document searching and displaying method according to claim 34, wherein when the conditions are met for the relative positions of occurrence of two query terms in the search query, the respective query terms constituting the search query are displayed in highlighted text with different display formats from each other; Claim 36. A structured document searching and displaying method according to claim 34, wherein each of a plurality of query terms constituting the search query and the whole element including said query terms are displayed in highlighted text with different display formats; Claim 37. A structured document searching and displaying method according to claim 34, wherein a highlighted display format for highlighted display is set using a method specified in said search.query; Claim 38. A structured document searching and displaying method according to claim 34, wherein the character string meeting the search query is displayed in highlighted text using any one of a plurality of highlight display formats for each query term; Claim 39. A structured document searching and displaying method according to claim 38, wherein the highlighted display format for each query term is determined based on occurrence frequency of each query term; and Claim 40. A structured document searching and displaying method according to claim 38, wherein the display format of highlighted display for each query term is determined based on the

information weighting predetermined for each query term. It would have been obvious to one having ordinary skill in the art at the time of the invention to have the steps of claims 35-40 because structured documents and documents in SGML or HTML perform the steps for claims 35-40 and the links show in highlighted text in a display format for each query term.

Claim 41. Tateno failed to disclose. A structured document searching and displaying method according to claim 34, wherein said step of generating a text string includes a step of producing the text string el- corresponding to the sub-elements to be displayed, from sub-elements of the analyzed structured document. Aoyama discloses, A structured document searching and displaying method according to claim 34, wherein said step of generating a text string includes a step of producing the text string el- corresponding to the sub-elements to be displayed, from sub-elements of the analyzed structured document (col. 8, lines 8-20 and col. 10, lines 1-28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Aoyama in Tateno because such an incorporation would allow Tateno to have a character string sandwiched by marks which is a logical structure (HTML (Hypertext Markup Language) which is used in WWW (World Wide Web) and an application of SGML.

Claim 46. This independent claim is rejected for the similar rationale as given above for claim 34.

Claim 47. This independent claim is rejected for the similar rationale as given for independent claims 34 and 46.

Response to Arguments

Applicants' arguments filed 07/01/08 have been fully considered but they are not persuasive.

Applicants' request for the withdrawal of the rejection and allowance of the claims has been carefully considered. However, the rejection above is still maintained for the following reasons: due to the recent changes in 35 USC 101 there is a 101 issue with claims 34-41. Claim 34 has a 35 U.S.C. 101 problem because based on the en banc Federal Circuit on October 30, 2008, *In re Bilski* (Fed. Cir., 2007-1130, 10/30/08) and on a Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972). If neither of these requirements is met by the claim(s), the method is not considered a patent eligible process under 35 U.S.C. § 101. It is no longer sufficient to have "A computer-implemented method" in the preamble, it must be in the body of the claim.

Therefore, the application is not in condition for allowance nor does it simplify matters for appeal.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

November 7, 2008

Application Number**Application/Control No.**

09/964,475

Examiner

Ella Colbert

**Applicant(s)/Patent under
Reexamination**

OKAMOTO ET AL.

Art Unit

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